

Appl. No. 10/048,082
Atty. Docket No. 7691
Amdt. dated January 13, 2004
Reply to Office Action of December 11, 2003
Customer No. 27752

REMARKS

Claims 2-10, 19, and 25-29 have been withdrawn from the instant Application pursuant to the Examiner's indication that these claims are drawn to non-elected inventions. Claim 1 has been amended to require that the shutter further comprise an integral latching mechanism. Support for the current Amendment to Claim 1 is found in the Specification on page 10, lines 9-16. Claim 22 has been amended to require that the shutter have a latching mechanism integral thereto. Support for this Amendment is found in the Specification on page 10, lines 9-16, as originally filed. Claims 1, 11-18, and 20-24 remain in this Application and are presented for the Examiner's review in light of the above Amendments and the following remarks. No new matter has been added.

Restriction Requirement

Claims 25-29 have been withdrawn from further consideration by the Examiner pursuant to 37 C.F.R. §1.142(b) as being drawn to a non-elected invention. Additionally, the Examiner has withdrawn Claims 2-10, 19, and 25 under 37 C.F.R. §1.142(b). The Examiner states that Claims 2-5 and 25 are directed toward biasing means that are disclosed as alternative embodiments to what is shown in the elected Figures 16-17 and has withdrawn these claims accordingly.

The Examiner is respectfully directed to 37 C.F.R. §1.475, which states, *inter alia*, where "a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." Further, M.P.E.P. §1850 states, "In applying PCT Rule 13.2 to international applications, . . . examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2." As stated previously, independent Claims 1 and 22 are directed toward a novel and unobvious microvalve. Additionally, independent Claim 26 is directed toward a novel and unobvious fluid-breathing voltaic battery comprising, *inter alia*, a microvalve. Thus, the Applicants respectfully believe the restriction requirement for Groups I and II is improper because both share a common technical feature.

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Upon allowance of Claims 1 and 22, Applicants respectfully request rejoinder of all claims dependent thereon pursuant to M.P.E.P. §821.04.

Rejection Under 35 U.S.C. §103

Claims 1, 15-18, and 21-24 were rejected under 35 U.S.C. §103 over Gschwendtner, et al., U.S. Patent No. 5,400,824, in view of Schumm, Jr., U.S. Patent No. 5,837,394. Applicants respectfully traverse this rejection for the following reasons:

1. Applicants' Claim 1, as now presented by Amendment, requires that the shutter further comprise an integral latching mechanism for preventing the shutter from moving with respect to the body portion.
2. Applicants' Claim 22, as now presented by Amendment, requires the shutter to have a latching mechanism integral thereto.
3. As the Examiner correctly states, the *Gschwendtner* reference does not teach latching the valve.
4. *Schumm* discloses four individual components that require assembly (i.e., a sliding valve 61, a latch, an actuator A (ACT A) and actuator B (ACT B). See Col. 7, 1. 66 – Col. 8, 1. 12; Fig. 8.
5. The *Schumm* reference does not disclose, teach, or suggest providing any latching mechanism integral with the shutter claimed by Applicants.

Due to these considerations, the *Gschwendtner* and *Schumm* references do not disclose, teach, suggest, or render obvious, either singly or in combination, every recited feature of Applicants' claimed invention. There must be a teaching or suggestion within the prior art or within the general knowledge of a person of ordinary skill in the field of the invention to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor. See *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 U.S.P.Q. 2d 1321 (Fed.Cir. 1998). Further, providing a latching mechanism integral with the shutter portion of a microvalve provides a simplified assembly for a microvalve system, thus providing previously unknown practical uses. Current federal circuit case law provides that advances providing previously unknown practical uses are not obvious. See *Intel Corp. v. U.S. Int'l. Trade Comm'n.*, 946 F.2d 821, 20 U.S.P.Q. 2d 1161 (Fed.Cir. 1991). Thus, Applicants believe independent Claims 1 and 22 of the instant invention to be unobvious over the cited prior art.

Because dependent Claims 11-18, 20-21, and 23-24 all depend directly or indirectly from Applicants' independent Claims 1 or 22, they contain all their respective limitations. For this reason, Applicants submit that the arguments made above concerning the allowability of

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independent Claims 1 and 22 are equally applicable to the claims dependent thereupon under 35 U.S.C. §103(a). Applicants therefore respectfully request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejections.

Conclusion

Based on all the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512. If any additional charges are due, the Examiner is authorized to deduct such charges from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

SHERMAN, ET AL.

By _____

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